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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,821	09/30/2003	Gregory E. Ward	H0003399	6648

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Honeywell International Inc.
101 Columbia Road
P.O. Box 2245
Morristown, NJ 07962

EXAMINER

MEISLIN, DEBRA S

ART UNIT PAPER NUMBER

3723

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,821

Applicant(s)

WARD ET AL.

Examiner

Debra S Meislin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 17-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 17-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1, 17-21 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, lines 14-16, "wherein a length of the aperture in the first direction is greater than or equal to a distance from the electrical connector end to the damaged wrench-engaging member" constitutes new matter unsupported by the original disclosure.

In claim 23, "rotating the torque application device in a second direction opposite the first direction..." constitutes new matter unsupported by the original disclosure.

2. Claims 1, 17-21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 2 of claim 1, "(he" should be ---the---. Lines 14-16 are directed to a length of the tool in relation to a workpiece. Since the workpiece is not a part of the claimed invention (a tool), the scope of the claim cannot be ascertained. Note also, that workpiece lengths can and do change.

In claim 23, it is not clear as to the operation of the device. It is not clear as to how the method of rotating the device in a first direction and then in a second direction provides for the removal and engagement of the spark plug.

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3. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not clear as to the structure that allows the method and how the method of rotating the device in a first direction and then in a second direction provides for the removal and engagement of the spark plug in view of the original specification and drawings.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 20 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by McLellan.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The device of McLellan is clearly capable of engaging a spark plug that has been damaged.

The device of McLellan has a length that allows for the engagement of a workpiece. Lines 14-16 are directed to a length of the tool in relation to a workpiece. Since the workpiece is not a part of the claimed invention (a tool), the length cannot be ascertained. Note also, that workpiece lengths can and do change.

6. Claims 1 and 17-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hildebrand.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The device of Hildebrand is clearly capable of engaging a spark plug that has been damaged.

The device of Hildebrand has a length that allows for the engagement of a workpiece. Lines 14-16 are directed to a length of the tool in relation to a workpiece. Since the workpiece is not a part of the claimed invention (a tool), the length cannot be ascertained. Note also, that workpiece lengths can and do change.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLellan or Hildebrand in view of Vasichек et al.

McLellan or Hildebrand disclose all of the claimed subject matter except for engaging the body of a damaged spark plug adjacent the damaged wrench-engaging member. McLellan or Hildebrand disclose a socket wrench for engaging a damaged threaded member (that would have normally been engaged by a standard socket wrench if undamaged) with damaged or sheared wrench surfaces to enable the threaded member to be rotated and backed out or removed. Vasichек et al discloses a socket wrench for engaging a threaded member with wrench surfaces to enable the threaded member to be rotated and backed out or removed. It is known in the art that spark plugs may become damaged preventing removal by the use of a normal socket wrench as admitted by applicant in the instant invention. Consequently, it would have been obvious to one having ordinary skill in the art to use the device of McLellan or Hildebrand on a spark plug that is damaged to rotate and remove the spark plug since McLellan or Hildebrand are designed for such purpose as described, above. The step of engaging the body of a damaged spark plug adjacent the damaged wrench-engaging member would clearly depend upon the amount of damage to the wrench-engaging member. Consequently, a spark plug with a rounded off wrench-engaging member would allow the device of McLellan or Hildebrand to engage the body thereof.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Applicant's arguments filed February 28, 2005 have been fully considered but they are not persuasive.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The device of McLellan or Hildebrand is clearly capable of engaging a spark plug that has been damaged.

The device of McLellan or Hildebrand has a length that allows for the engagement of a workpiece. Lines 14-16 are directed to a length of the tool in relation to a workpiece. Since the workpiece is not a part of the claimed invention (a tool), the length cannot be ascertained. Note also, that workpiece lengths can and do change.

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With respect to claims 22 and 23 applicant's attention is directed to paragraph 8, above, for claim 22 and to paragraphs 1-3, above, regarding claim 23.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Debra S Meislin
Primary Examiner
Art Unit 3723

April 13, 2005